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# In the Supreme Court of the United States

**OCTOBER TERM, 1940.**

## No. 808.

KENNETH S. CLAPP,
*Plaintiff-Petitioner,*

vs.

STEWART-WARNER CORPORATION,
*Defendant-Respondent.*

## PETITIONER'S REPLY BRIEF.

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## PETITIONER'S REPLY BRIEF.

### A. ONLY TWO POINTS OF LAW PRESENTED TO THIS COURT.

The petitioner, Kenneth S. Clapp, respectfully redirects your Honors' attention to the two conflicting grounds as set forth in the Petition for Writ of Certiorari. The Seventh Circuit Court of Appeals made its decision of non-infringement upon these two grounds and these two grounds only:

**First Ground:**

Because the accused "Rock Crushers" are "always *sold and used* with a delivery hose attached, the hose being fitted at its forward end with a coupler by which it is attachable to the lubricant fitting."

This ruling that the "Rock Crushers" escape from the scope of the Baldner claims in suit because the claims do not include the hose, coupler and fitting, is in direct conflict to this Court's decisions in *Rogers vs. Alemite* (298 U. S. 415) and *Lincoln vs. Stewart-Warner* (303 U. S. 545).

The defendant-respondent has failed completely to meet this issue in its Answer Brief.

**Second Ground:**

Because in the accused "Rock Crushers" "there is *no way of knowing* how many cubic inches of lubricant may be used" as there is no gauge, meter or other counting or indicating mechanism added to the structure of the "Rock Crushers."

This ruling that the "Rock Crushers" avoid the infringement of the patent because they do not include in their structure any means of providing a "way of knowing" or to "tell how much grease" may be used, which additive feature is also disclosed in the "entire specification" of the Baldner patent but which is *not* included in the claims in suit, is in direct conflict with this Court's decisions in *Continental Paper Bag Co. vs. Eastern Paper Bag Co.* (210 U. S. 405); *Leeds and Catlin vs. Victor Talking Machine Co.* (213 U. S. 301); *Altoona Theaters vs. Tri-Ergon Corp.* (294 U. S. 477) and other cases, holding that patent claims rather than the specification measure the scope of the patent.

The defendant-respondent has failed completely to meet this second issue in its Answer Brief.

**B. THE BALDNER CLAIMS IN SUIT DO NOT INCLUDE A GAUGE OR METER TO PROVIDE A "WAY OF KNOWING" OR TO "TELL HOW MUCH" GREASE IS DISPENSED DURING A PERIOD OF OPERATION.**

Again, example claim 3 reads:

> "3. In an apparatus of the character described, a reservoir, an ejector communicating therewith dividing the discharged material into successive charges of known capacity and conveyor means for supplying the material to the ejector in quantity greater than its capacity whereby said ejector will act to impede the normal flow of the material under influence of the first ejector and will be operated at full capacity to discharge the material in known measured quantity."

This claim reads squarely upon the accused "Rock Crushers." The defendant-respondent has been unable to point out in the claim anything which may be called a gauge or meter to provide a "way of knowing" or to "tell how much" grease is dispensed during a period of operation. This is inevitable because the claim calls for nothing more than that which is found in the accused "Rock Crushers."

The claimed machine and the accused machine have, as defined by claim 3:

1. A reservoir.
2. An ejector (positive-displacement booster or pump of fixed volume and capable of producing 7000 pounds pressure per square inch in the Baldner device and 5000 pounds per square inch in the "Rock Crusher") communicating therewith dividing the discharged material into successive charges of known capacity.
3. Conveyor means (screw conveyor producing an impositive feed) for supplying the material to the positive-displacement ejector in quantity greater than its capacity whereby said positive-displacement ejector will act to impede the normal flow of the material under influence of the first ejector (screw conveyor). The supplying of the grease in quantity greater than the positive-displacement ejector enables the screw conveyor to pack the grease *solid* against the intake orifice of the positive displacement ejector to expel or churn out the air contained in the air pockets or grease. This is the provision which prevents the positive-displacement ejector from becoming "air bound." Accordingly, the positive displacement ejector is always filled with *solid* grease and is operated at *full capacity* or in *known measured quantity* devoid of air pockets. Each ejection stroke delivers a *full* increment of grease.

The "measured quantity" last referred to in the claim is in the *singular* rather than in the plural. There is no

reference in the claim to provide a "way of knowing" or to "tell how much" grease is dispensed during a period of operation. As explained in the Petition for Writ of Certiorari, the Baldner patent specification besides showing and describing his power driven two-stage grease-dispensing machine, as claimed for example in claim 3, also shows and describes a small meter, dial or gauge and an electrical switch-controlling circuit which may be optionally superimposed upon the grease-dispensing machine to provide a "way of knowing" or to "tell how much" grease may be used. The counting meter, dial or gauge is the subject matter of other claims not in suit. There has been no charge that the defendant-respondent has used the counting meter, dial or gauge to provide a "way of knowing" or to "tell how much" grease has been used. The charge of infringement is directed toward the large grease-dispensing machine, *per se*.

Without investigating the claims and obliviously disregarding the content of the claims, the Court of Appeals found a basis for its decision by refusing to use the claims as a measure of the invention to be protected. Instead of following the principle established by the decisions of this Court, the Circuit Court of Appeals took the "entire specification" rather than the claims as the measure of the patent.

**C. THE TERMINOLOGY OF THE CIRCUIT COURT OF APPEALS HAS BEEN ADOPTED BY THE PLAINTIFF-PETITIONER.**

As it is the decision of the Circuit Court of Appeals of which review and reversal is sought, the particular language used by that Court has been adopted by the plaintiff-petitioner. It is fully apparent from the contents of the opinion of the Court of Appeals that in that Court's language a meter is a counting or indicating mechanism for recording the total amount of grease dispensed during a greasing operation. The Court of Appeals demonstrated

the meaning with which it used the word "meter," by such statements as:

> "There is no meter or gauge of any kind included in the structure (of the Rock Crushers) which is used or usable to measure the quantity of grease discharged, and in lubricating a car there is *no way of knowing* how many cubic inches of lubricant may be used." (R-II 1044.)

> "Appellee was not concerned with the exact amount that it was delivering for the benefit of the purchaser. Its object was to deliver whatever was necessary for greasing the bearings, and no one *could tell how much* that would be. Under these circumstances a meter was not necessary to accomplish appellee's objects, and the accused devices have no such means." (R-II 1045.)

Therefore, the Court of Appeals used the word "meter" in the sense of an instrument for indicating and recording automatically the total quantity measured over a period of time; that is, in the sense of a gauge to provide a "way of knowing" or to "tell how much" grease has been used. This is also apparent from the manner in which the Court interchangeably used the word "meter" and the word "gauge." The context of the opinion by the Court of Appeals makes it very clear that it exculpated the accused "Rock Crushers" from the charge of infringement because they do not include any counting or indicating instrument for recording the total quantity of grease dispensed during a greasing operation. This unwarranted decision was made in the face of the unquestioned fact that the claims in suit do not include nor attempt to include any counting or indicating instrument to provide a "way of knowing" or to "tell how much" grease has been used.

In a different sense (but not in the sense used by the Court of Appeals) the word "meter" is a designation sometimes applied to a positive-displacement pump which, upon each successive ejection stroke, forcibly discharges the *same amount* of grease, provided, of course, that the ejection chamber has been completely filled with solid grease.

In this sense, each ejection delivers a full increment of grease.

The characteristic of discharging the same, full increment of grease upon each successive ejection stroke spells *full capacity*. In this particular sense a meter is a full-capacity pump. The Baldner final ejector and the Rock Crusher final ejector are both full-capacity pumps. Both are interchangeable with each other and they are both meters (in the sense of full capacity). The "full-capacity" nature of the final ejector or pump of the "Rock Crushers" is admitted in the defendant-respondent's advertising literature (R-I 507 to 519; of which excerpts are reproduced as Appendix A of this Brief).

The patent specification signed by Baldner variously refers to his final ejecting mechanism as a booster or auxiliary ejector or pump, and as a "meter" (in the sense of full capacity) for forcibly advancing the grease. Any of these words equally describe the final, positive-displacement ejecting mechanism of both the Baldner and the Rock Crusher machines. The word booster (quoted by Baldner in his specification) is a term which has a definite meaning in the grease dispensing art, and is sufficient, in and of itself, to stamp the final ejecting mechanism of the Baldner patent as a high pressure pump, which under tests in court actually produced 7000 pounds pressure per square inch.

In claim 3, Baldner describes his final ejecting mechanism as an ejector. The Court of Appeals totally disregarded this fact and instead took the "entire specification" as the measure of the patent. The claim 3 does not include nor does it attempt to include any counting or indicating instrument to provide a "way of knowing" or to "tell how much" grease has been used.

The word meter or rotary meter repeatedly printed in bold letters in the defendant-respondent's Answer Brief refers to the final ejecting mechanism in the sense of full capacity, that is in the sense of delivering the same, full in-

crement of grease upon each ejection stroke and not in the sense, as used by the Court of Appeals, to provide a "way of knowing" or to "tell how much" grease has been used. In the Petition for Writ of Certiorari, the plaintiff-petitioner has used the word "meter" in the same terminology and language used by the Court of Appeals in its decision under review. Therefore, the portion of the defendant-respondent's Answer Brief dealing with the word "meter" (used in the sense of a full-capacity pump) particularly where it is printed in bold letters, is irrelevant and immaterial as being inconsistent with the word "meter" (used in a sense of providing a "way of knowing" or to "tell how much" grease has been delivered) as described in the language of the Court of Appeals.

**D. THE DEFENDANT-RESPONDENT HAS DEVOTED ITS ANSWER BRIEF TO MATTERS THAT ARE NOT IN ISSUE BEFORE THIS COURT.**

The bulk of the defendant-respondent's Answer Brief filed in this Court is comprised of the very same arguments which it urged without avail upon the Seventh Circuit Court of Appeals. The opinion of the Court of Appeals demonstrates that the Court was not satisfied with these arguments as a basis for its decision but rather insisted upon basing its decision on the two grounds which have been shown to be in conflict with the prior decisions of this Court.

In the appeal to the Circuit Court of Appeals the alleged "prior art" was thoroughly briefed and argued. (This "prior art" included the Battenfeld *brick-making* machine of which a partial and inadequate view is shown facing page 16 of the defendant-respondent's Answer Brief. It was demonstrated to the Court of Appeals by briefs and arguments that brick-making machines are from a *non-analogous* art and that the only and *uncontroverted* testimony of record showed many structural and operative differences between the Battenfeld brick-making machine and the Baldner and the Rock Crusher machines and the only

and *uncontroverted* testimony further established that the Battenfeld machine would *not work* to dispense grease. The defendant-respondent for its own purpose has failed to refer to the Record when discussing the Battenfeld brick-making machine.) As a result of the thorough exposure of the alleged "prior art" by the briefs and arguments submitted to it, the Circuit Court of Appeals declined to base its decision upon such "prior art" but instead based its decision *solely* upon the two grounds presented to this Court by the Petition for Writ of Certiorari.

In the appeal to the Circuit Court of Appeals the question of the effect of the file wrapper statements by the solicitor prosecuting the Baldner patent application was thoroughly briefed. (This issue included the portions of the solicitor's statements now quoted in the defendant-respondent's Answer Brief which, however, omits any reference to the Patent Office Examiner's full answer thereto and to the subsequent *abandonment* thereof, and fails to refer to the only testimony of record upon the real nature of the patent prosecution history demonstrating that these statements do not limit the scope of the patent under the controlling decisions.) As a result of the analytical exposition of the true nature and significance of these "file wrapper statements" by the briefs submitted to it, the Circuit Court of Appeals declined to base its decision upon such "file wrapper statements" but instead based its decision *solely* upon the two grounds presented to this Court by the Petition for Writ of Certiorari.

In the appeal to the Circuit Court of Appeals the charge that the Baldner patent was "a mere paper patent" for purposes of construction was thoroughly briefed and considered. (This was briefed even though the charge of "paper patent" had been *expressly withdrawn* by defendant-respondent's counsel in the trial court upon it being shown that the plaintiff-appellant was thwarted in his endeavor to commercially manufacture his embodiment of the

Baldner grease-dispensing machine because of the defendant-respondent's monopoly upon couplers and fittings attachable to the end of the grease hose: R-I 35-36, 86; also reproduced as Appendix B attached to this Brief). As a result of the full revelation of the commercial history of the Baldner patent by the briefs submitted to it, the Circuit Court of Appeals declined to base its decision upon such a charge of "paper patent" but instead based its decision *solely* upon the two grounds presented to this Court by the Petition for Writ of Certiorari.

It is therefore found that the reiterated arguments submitted to this Court by the defendant-respondent's Answer Brief have already been urged before the Court of Appeals and have there been found wanting. The Court of Appeals refused to adopt these now repeated arguments as grounds for its decision but rather determined to base its decision solely upon the two grounds set forth in the Petition for Writ of Certiorari.

**E. THE BALDNER PATENT HAS BEEN EXPRESSLY FOUND BY THE CIRCUIT COURT OF APPEALS TO BE ENTITLED TO THE PRESUMPTION WHICH THE ISSUANCE OF THE PATENT BESTOWS UPON IT.**

The plaintiff-petitioner has stated in his Petition for Writ of Certiorari and in his supporting Brief that the Seventh Circuit Court of Appeals adjudged the Baldner patent valid and had refused to apply any prior art to anticipate or restrict the claims in suit. This statement has been challenged by the defendant-respondent as a misrepresentation.

The following quoted portion of the opinion by the Seventh Circuit Court of Appeals is submitted for the purpose of an examination of the charge of misrepresentation.

> "Other questions are raised which bear on the question of validity. However, appellee admits no concern in the question of validity, in view of our interpreta-

tion of the patent. While the District Court held the patent was invalid, even if there was infringement, yet, it cited no specific prior art upon which that judgment was based. Under these circumstances we deem it unnecessary to express any opinion on the question of validity, and leave appellant with *the benefit of the presumption which the issuance of the patent bestows upon it.*" (R-II 1046.)

It is again submitted as a solemn representation to this Court that by the above quoted statement the Seventh Circuit Court of Appeals refused to apply any prior art to anticipate or restrict the claims in any degree and *found the patent and the claims in suit to be valid.*

This representation is made by reason of the expressed statement of the Circuit Court of Appeals in its opinion and by reason of the assurance given by the decisions of this Court and of other Courts as to the meaning and legal significance of that statement.

This Court has expressly decided that the presumption which attaches to the issuance of a patent is the presumption of *validity.* That a duly issued patent is *presumed valid* has been repeatedly stated in the decisions of this Court, as for example:

"As this Court said in *Cantrell v. Wallick,* 117 U. S. 689, 695, 696: 'For the grant of letters patent is *prima facie evidence* that the patentee is the first inventor of the device described in the letters patent and of its novelty. *Smith vs. Goodyear Dental Vulcanite Co.,* 93 U. S. 486; *Lehnbeuter v. Holthaus,* 105 U. S. 94.' The issue of the patent is enough to show, until the contrary appears, that all the conditions under which a discovery is patentable in accordance with the statutes have been met. Hence, the burden of proving want of novelty is upon him who avers it. *Walker on Patents,* Section 116. Not only is the burden to make good this defense upon the party setting it up, but his burden is a heavy one, as it has been held that 'every reasonable doubt should be resolved against him.'" *Muxim v. Decker,* 301 U. S. 168, 171.

"A patent regularly issued, and even more obviously a patent issued after a hearing of all the rival claimants, is *presumed to be valid* until the presumption has been overcome by convincing evidence of error. The force of that presumption has found varying expression in this and other courts. Sometimes it is said that in a suit for infringement, when the defense is a prior invention, 'the burden of proof to make good this defense' is 'upon the party setting it up,' and 'every reasonable doubt should be resolved against him.'" *Radio Corp. of America vs. Radio Engineering Laboratories,* 293 U. S. 1, 7.

To the same effect are the cases of:

*Cantrell vs. Wallick,* 117 U. S. 689, 695;

*Morgan vs. Daniels,* 153 U. S. 120, 123;

*Smith vs. Goodyear,* 93 U. S. 486, 498.

That the Seventh Circuit Court of Appeals understood the full import of its words and did expressly adjudge the Baldner patent valid, is shown by other decisions of that Court, for example:

"Want of invention so apparent on the face of the patent as to demand the court's dismissal of a complaint based thereon, even before an answer or hearing on the merits, has on many occasions provoked discussion by courts, with the conclusion that the court's inclination to hold the patent so lacking in invention is generally overcome by *the presumption of validity which attends the issuance of every patent.*"

*Gatch Wire vs. Laidlaw,* 108 Fed. 2nd 433, 435 (C. C. A. 7).

The same Court recognized that issuance of a patent carries with it the presumption of validity, in the cases of:

*Crowder vs. Armour,* 105 Fed. 2nd 232, 237 (C. C. A. 7);

*Wisconsin Alumni vs. Breon,* 85 Fed. 2nd 166, 167 (C. C. A. 7).

Therefore, it may be stated with confidence that the Seventh Circuit Court of Appeals adjudged the Baldner patent to be *valid* when it found it to be entitled to "the presumption which the issuance of the patent bestows upon it." The patent claims, being valid, describe a new and useful invention in the art of grease dispensing, to wit; a two-stage grease-dispensing machine or grease-gun in which an *im*positive-displacement screw-conveyor continuously feeds grease from a reservoir to a positive-displacement intermittent booster or pump positively inter-geared therewith, at a rate-of-feed *greater* than the displacement rate of the booster;—to the end that, upon the intake stroke or movement of the piston, the chamber of the booster is *completely filled* at each and every stroke (instead of becoming "air-bound") and that, upon the discharge stroke or movement of the piston, the discharged grease is ejected from the booster or pump in a *uniform and continuous flow* (instead of spasmodic spluttering with air pockets or instead of ceasing to flow altogether).

## CONCLUSION.

This Court is presented with two issues and two issues only. These are the two grounds upon which the Seventh Circuit Court of Appeals based its decision in this case and which are in direct conflict with the decisions of this Court upon the same points. The defendant-respondent in directing its Brief to extraneous issues not before this Court has failed to answer the questions presented by the Petition for Writ of Certiorari.

The plaintiff-petitioner respectfully requests the allowance of his Petition.

Respectfully submitted,

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